UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/643,554	08/22/2000	Richard Alan Fiedotin	61018-0008-US	9688

24341 7590 06/03/2004	EXAMINER
MORGAN, LEWIS & BOCKIUS, LLP.	GILLIGAN, CHRISTOPHER L

MORGAN, LEWIS & BOCKIUS, LLP.
3300 HILLVIEW AVENUE
PALO ALTO, CA 94304

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 January 2004*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-30* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5*.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

Response to Amendment

1.   In the amendment filed 1/15/04 in paper number 6, the following has occurred: claims 1,

4, 11, 15-16, 22, and 24 have been amended, claim 2 has been canceled, and claims 26-30

have been added. Now, claims 1 and 3-30 are presented for examination.

2.   The rejections under 35 U.S.C. 112 are withdrawn by the Examiner based on changes

made by Applicants to the claims.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or
> described as set forth in section 102 of this title, if the differences between the subject
> matter sought to be patented and the prior art are such that the subject matter as a
> whole would have been obvious at the time the invention was made to a person having
> ordinary skill in the art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

4.   Claims 1 and 3-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Mayaud, U.S. Patent No. 5,845,255 in view of PR Newswire, **nevoca.com Enhances**

Prescription Verification System (hereinafter nevoca) and further in view of Sekura et al.,

U.S. Patent No. 6,198,383.

5.   As per claim 1, Mayaud teaches a method for renewing a prescription for a

pharmaceutical via an electronic network, comprising the steps of: generating a prescription

renewal request for the renewal of a prior prescription (see column 19, lines 48-53 and lines 63-

67); receiving a renewal prescription, in response to said prescription renewal request from a

prescriber (see column 20, lines 50-60); and notifying a dispenser to fill said renewal

prescription (see column 20, lines 5-11 and column 32, lines 23-25). While Mayaud appears to

teach transmission of the renewal request via face-to-face interaction between patient and

prescriber, it is unclear exactly how the patient requests the prescription renewal. Nevoca teaches a system for electronically communicating prescription renewal requests to doctors as a result of call-in or walk-in requests prior to the prescription expiring (see paragraph 7). It would have been obvious to one of ordinary skill in the art of prescription management at the time of the invention to include this feature in the system of Mayaud. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of decreasing time spent processing prescriptions (see paragraph 2 of nevoca).

6.   Additionally, neither Mayaud nor nevoca teach computer monitoring an expiration date of a prescription and generating the prescription renewal request based on said computer monitoring. Sekura teaches a method for monitoring the number of days until prescription renewal and alerting a user of the prescription renewal (see column 16, lines 39-43). It would have been obvious to one of ordinary skill in the art of prescription management at the time of the invention to incorporate this feature into the system of Mayaud along with the teachings of nevoca. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of aiding a patient with managing various different medication regimens (see column 1, lines 47-50 of Sekura).

7.   As per claim 3, Mayaud in view of nevoca and Sekura teach the method of claim 1 as described above. Mayaud further teaches the generating step further comprises creating said prescription renewal request from the following: a patient identifier, a pharmaceutical identifier, a dispenser identifier, a prescription identifier, a prescriber identifier, a dosage, number of refills, and a strength (see Figure 3).

8.   As per claim 4, Mayaud in view of nevoca and Sekura teach the method of claim 1 as described above. Mayaud further teaches prior to said receiving step, providing information

useful to said prescriber for reviewing said prescription renewal request (see column 20, lines
32-40).

9.   As per claim 5, Mayaud in view of nevoca and Sekura teach the method of claim 4 as
described above. Mayaud further teaches said information is selected from the following:
warnings for any drug-drug reactions, formulary listings, patient medication history, and low cost
therapeutic alternatives (see column 20, lines 20-40 and column 21, liens 34-51).

10.   As per claim 6, Mayaud in view of nevoca and Sekura teach the method of claim 1 as
described above. Mayaud further teaches said receiving step further comprises the step of
acquiring a renewal prescription, wherein said renewal prescription has components that have
been changed from said prior prescription (see column 20, lines 50-56, note that the renewal
takes place "after editing").

11.   As per claim 7, Mayaud in view of nevoca and Sekura teach the method of claim 6 as
described above. Mayaud further teaches said components are selected from the following: a
patient identifier, a pharmaceutical identifier, a dispenser identifier, a prescription identifier, a
prescriber identifier, a dosage, number of refills, and a strength (column 20, lines 50-56 and
Figure 3).

12.   As per claim 8, Mayaud in view of nevoca and Sekura teach the method of claim 1 as
described above. Mayaud further teaches said receiving step further comprises the step of
acquiring an appeal from said prescriber for a patient of said prior prescription to contact said
prescriber (see column 23, lines 29-39).

13.   As per claim 9, Mayaud in view of nevoca and Sekura teach the method of claim 8 as
described above. Mayaud further teaches said acquiring step further comprises notifying said
dispenser to inform said patient to contact said prescriber (column 23, lines 29-39).

14.   As per claim 10, Mayaud in view of nevoca and Sekura teach the method of claim 8 as described above. Mayaud further teaches said acquiring step further comprises notifying said patient to contact said prescriber (see column 23, lines 29-39).

15.   As per claim 11, Mayaud in view of nevoca and Sekura teach the method of claim 1 as described above. Mayaud further teaches the steps of claim 1 occur for a plurality of prescription renewal requests and renewal prescriptions (see column 20, lines 50-60).

16.   As per claim 12, Mayaud in view of nevoca and Sekura teach the method of claim 1 as described above. Mayaud does not explicitly teach ascertaining a status of said prescription renewal request. Nevoca teaches ascertaining a status of said prescription renewal request (see paragraph 9). It would have been obvious to one of ordinary skill in the art of prescription management at the time of the invention to include this feature in the system of Mayaud. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of decreasing time spent processing prescriptions (see paragraph 2 of nevoca).

17.   As per claim 13, Mayaud in view of nevoca and Sekura teach the method of claim 12 as described above. Mayaud does not explicitly teach determining how many prescription renewal requests were transmitted to said prescriber and establishing how many prescription renewal requests said prescriber has addressed. Nevoca teaches these determining and establishing steps (see paragraph 9, the Examiner asserts that these steps would be necessary to determing the "exact status" when a doctor has not yet responded to a prescription renewal request). It would have been obvious to one of ordinary skill in the art of prescription management at the time of the invention to include this feature in the system of Mayaud for the reasons given above with respect to claim 12.

18.   As per claim 14, Mayaud in view of nevoca and Sekura teach the method of claim 12 as described above. Mayaud does not explicitly teach sending the status to said prescriber.

Nevoca teaches said ascertaining step further comprises the step of sending said status to said prescriber (see paragraphs 4 and 9). It would have been obvious to one of ordinary skill in the art of prescription management at the time of the invention to incorporate this feature into the system of Mayaud for the reasons given above with respect to claim 1.

19.   As per claim 15, Mayaud in view of nevoca and Sekura teach the method of claim 1 as described above. Mayaud further teaches deleting said electronic prescription renewal request after a set time (see column 15, lines 41-47).

20.   As per claim 16, Mayaud in view of nevoca and Sekura teach the method of claim 1 as described above. Mayaud further teaches deleting said renewal prescription after a set of time (see column 15, lines 41-47).

21.   As per claim 17, Mayaud in view of nevoca and Sekura teach the method of claim 1 as described above. Mayaud further teaches accepting said prescription renewal request using a portable computing device (see column see column 7, lines 57-67); displaying said prescription renewal request, via said portable computing device, to said prescriber (see column 7, lines 57-67); showing said prescriber information, via said portable computing device, useful for reviewing said prescription renewal request (see column 7, lines 57-67 and Figure 3); and communicating said renewal request to using said portable computing device (see column 7, lines 57-67 and Figure 3, in particular, reference 80). Mayaud does not explicitly teach electronic transmission of a request via a server as described above with respect to claim 1. Nevoca teaches a system for electronically communicating prescription renewal requests to doctors as a result of call-in or walk-in requests (see paragraphs 4 and 7, note that communication is done on-line through nevoca.com and, as such, requires a host server). It would have been obvious to one of ordinary skill in the art of prescription management at the time of the invention to include this feature in the system of Mayaud. One of ordinary skill in the

art would have been motivated to incorporate this feature for the purpose of decreasing time

spent processing prescriptions (see paragraph 2 of nevoca).

22.   As per claim 18, Mayaud in view of nevoca and Sekura teach the method of claim 1 as

described above. Mayaud further teaches receiving said prior prescription (see column 20, lines

50-51); determining whether a prescribed pharmaceutical from said prior prescription is on

formulary (see column 32, lines 7-13); and dispensing said prescribed pharmaceutical based on

said determining step (see column 32, lines 23-25).

23.   As per claim 19, Mayaud in view of nevoca and Sekura teach the mthod of claim 18 as

described above. Mayaud further teaches ascertaining whether said prescribed pharmaceutical

is a chronic medication (see column 20, lines 41-49 and Figure 3, the patient history would

indicate if a prescription had been prescribed for a chronic illness); and storing a result of said

ascertaining step (see column 20, lines 41-49 and Figure 3, this result is at least temporarily

stored in the memory of the portable computing device).

24.   As per claim 20, Mayaud in view of nevoca and Sekura teach the method of claim 1 as

described above. Mayaud further teaches the initial step of determining whether refills are

available for said prior prescription (see Figure 3, reference 100).

25.   As per claim 21, Mayaud in view of nevoca and Sekura teach the method of claim 1 as

described above. Mayaud further teaches obtaining a patient record, said record containing at

least a patient identifier, a pharmaceutical identifier for a currently prescribed pharmaceutical, a

number of authorized refills of the currently prescribed pharmaceutical, and a date of the last

filling of the currently prescribed pharmaceutical (see Figure 3); and setting a renewal date

before a last refill has been consumed by a patient if said number of authorized refills is greater

or equal to a predetermined number (see column 26, lines 57-60).

26.   Claims 22 and 23 contain substantially similar limitations to claims 1, 5 and 17 and, as such, are rejected for similar reasons as given above.

29.   Claims 24 and 25 contain substantially similar limitations to claims 1 and 17 and, as such, are rejected for similar reasons as given above.

30.   As per claim 26, Mayaud in view of nevoca and Sekura teach the method of claim 1 as described above. Mayaud further teaches setting a renewal date prior to expiration of said prescription (see column 20, lines 50-56). Mayaud does not explicitly teach determining when a prescription will expire and determining whether said renewal date has been reached. Sekura teaches a method for determining when a prescription will expire and determining whether a renewal date has been reached (see column 16, lines 39-43). It would have been obvious to one of ordinary skill in the art of prescription management to incorporate this feature into the system of Mayaud along with the teachings of nevoca for the reasons given above with respect to claim 1.

31.   As per claim 27, Mayaud in view of nevoca and Sekura teach the method of claim 1 as described above. Mayaud further teaches the steps of claim 1 occur simultaneously for multiple prescriptions for a single patient (see column 20, lines 5-13).

32.   As per claim 28, Mayaud in view of nevoca and Sekura teach the method of claim 1 as described above. Mayaud further teaches the steps of claim 1 occur simultaneously for multiple prescriptions for multiple patients (see column 4, lines 48-55).

33.   As per claim 29, Mayaud in view of nevoca and Sekura teach the method of claim 1 as described above. Neither Mayaud nor nevoca explicitly teach the computer monitoring as described above with respect to claim 1. Howevero, Sekur teaches said computer monitoring occurring without patient intervention (see column 16, lines 39-43, although the patient interacts with the device, the actual monitoring occurs without patient intervention). It would have been

obvious to one of ordinary skill in the art of prescription management to incorporate this feature

into the system of Mayaud along with the teachings of nevoca for the reasons given above with

respect to claim 1.

34.   As per claim 30, Mayaud in view of nevoca and Sekura teach the method of claim 1 as

described above. Mayaud further teaches the steps of claim 1 can occur at a location remote

from a patient of said prescription and said dispenser (see column 7, lines 21-29).

Response to Arguments

35.   In the remarks filed 1/15/04 in paper number 6, Applicants argue in substance that

neither Mayaud nor nevoca teach computer monitoring an expiration date of a prescriptions and

generating a new prescriptions prior to the expiration date based on the monitoring. The

Examiner has fully considered this argument but it is now moot in view of the new grounds of

rejection detailed above. In particular, the Examiner has relied upon the teaches of Sekura for

this limitation.

Conclusion

36.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant

is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

37.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37
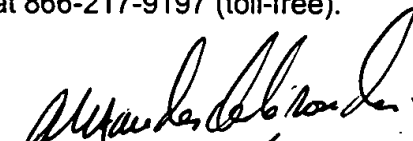
CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

38.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (703) 308-6104. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

39.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

40.   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CLG
5/24/04

ALEXANDER KALINOWSKI
AU 3626
PRIMARY EXAMINER